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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,634	09/28/2001	Walter Kuzma Stepanenko	10541/296	5066
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BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60611				
EXAMINER				
SAWHNEY, HARGOBIND S				
ART UNIT		PAPER NUMBER		
2875				

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,634

Applicant(s)

STEPANENKO ET AL

Examiner

Hargobind S Sawhney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 20-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-12 and 14-19 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed on June 2, 2003 has been entered. Accordingly, claims 1 and 14 have been amended, and claims 20-29 have been withdrawn from further consideration.
2. The indicated allowability of claims 9 and 10 is withdrawn in view of the further examination and newly discovered reference(s) to Hicks (U.S. Patent No. 6,079,858). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 and 14-19 are rejected under 35 U.S.C. 102(e) as being anticipated by DeLine et al. (U.S. Patent No. 6,124,886).

Regarding claims 1-5, DeLine et al. ('886) discloses an integrated light and accessory assembly 10 (Figure 1, column 7, line 17) comprising:

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- an insulator 20 (Figure 1, column 7, lines 22 and 23) and reflectors 110 and 112 (Figure 1, column 7, line 35) mounted on the insulator 20 (Figure 1)
- a conductor 62 (Figures 1 and 4, column 9, lines 12,13,18,19 ,64 and 65) being connected to the insulator 20 (Figures 1 and 4);
- a plurality of lamps 130 (Figure 1, column 7, lines 34-38) being connected to the conductor 62, and assembled inside the respective reflectors 110 and 120 (Figure 1, column 7, lines 15-18);
- a control module 72a (Figures 1 and 4, column 9, lines 29-32) mounted on the insulator 20 (Figure 1);
- a housing 12 (Figure 1, column 7, lines 18 and 19) enclosing the insulator 20, the reflectors 110 and 112, the conductor 62 and the control module 72a;
- the lamp 130 and the reflector 110 providing illumination, and the control module 72a being a lighting control module (Figure 1, column 7, lines 15-18);
- the lamp 130 being an incandescent lamp (Figure 24), and being an interior lamp – attached to the rear view mirror - (Figure 1); and
- the lamp 130 being releasably mounted inside the housing (Figure 1, column 7, lines 36-39).

Regarding Claims 14, DeLine et al. ('886) discloses an integrated light and accessory assembly 500 (Figure 47, column 27, lines 12 and 13) comprising:

- an insulator 510 (Figure 47, column 28, lines 5-16) and reflectors included in lamp 130 or 508h (Figures 1 and 47, column 29, lines 19 and 20) mounted on the insulator 510 (Figure 47)

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- the insulator 510 (Figure 47, column 28, lines 13-17) – a circuit board also acting as an insulator– inherently carrying conductors embedded in it;
- at least one lamp 508h (Figure 47, column 29, lines 19 and 20) being connected to the conductor embedded in the insulator 510, and assembled inside the respective reflector included in the lamp 508h (Figure 47);
- an electronic module 508i (Figure 47, column 30, lines 61-64) mounted on the insulator – also a circuit board - and inherently connected to the conductor embedded in the insulator;
- a housing 502,507 (Figure 47, column 27, line 13)- the housing having a first compartment 502 and a second compartment 507- enclosing the reflector, conductor embedded in the insulator 510, lamp 508h and electronic module 508i; and
- the lamp 508h being an illuminator – reading light – (Figure 47, column 30, lines 61-64); and conductor and the electronic module 508i receiving electric power through circuit board 510;
- the electronic module 508i being a transmitter for an automatic toll transponder (Figure 47, column 30, line 61 and 62; and
- a video device 508 d (Figure 47, column 29, lines 15 and 16).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-8, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLine et al. (U.S. Patent No. 6,124,886).

Regarding claims 6 and 7, dependent on Claim 1, DeLine et al. ('886) teaches an insulator 20 comprising a receptacle connecting in a PC circuit board for various functions with the mounting of mirror assembly (Figures 1 and 30). However, DeLine et al. ('886) does not teach a device mounted to the insulator of the first embodiment of the invention. On the other hand, DeLine et al. ('886) discloses a modular rear-view mirror assembly 270 (Figures 30 and 31, column 17, lines 29-31) comprising a first forward facing light sensor (not shown, column 17, line 49 and 50) extending through the rear wall 280 (Figure 30); and a second sensor (not shown, column 17, lines 50 and 51) facing rearwardly.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the first embodiment of the integrated light and accessory assembly of DeLine et al. ('886) by adding light sensors as taught by him only for

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benefits and advantages of advantages of size reduction and economical electronic packaging.

Regarding Claim 8, dependent on Claims 6, DeLine et al. ('886) does not teach in the first embodiment of integrated light and accessory assembly comprising a transmitter. However, DeLine et al. ('886) teaches sixth embodiment of a modular rearview assembly 500 (Figure 47) comprising a transmitter 508l performing automatic toll booth function (Figure 47, column 30, lines 61-64).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the first embodiment of the integrated light and accessory assembly of DeLine et al. ('886) by adding a transmitter as taught by him only for benefits and advantages of advantages of size reduction and economical electronic packaging.

Regarding Claims 11 and 12, dependent on Claims 1 and 11 respectively, DeLine et al. ('886) teaches an insulator 20 comprising a receptacle 92 (Figure 1) connecting in a PC circuit board for various functions with the mounting of mirror assembly (Figures 1 and 30). However, DeLine et al. ('886) does not teach an additional functional module connected to an additional conductor mounted on the insulator of the first embodiment of the invention.

On the other hand, DeLine discloses a sixth embodiment of a rearview mirror lamp assembly 500 (Figure 47) comprising a functional module 508i connected to the additional conductor 92 (Figure 1), and performing automatic toll booth function (Figure 47, column 30, lines 61-64).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the first embodiment of the integrated light and accessory assembly of DeLine et al. ('886) by adding a additional module as taught by him only for benefits and advantages of advantages of size reduction and economical electronic packaging.

7. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLine et al. (U.S. Patent No. 6,124,886) in view of Hicks (U.S. Patent No. 6,079,858).

Regarding claims 9 and 10, DeLine et al. ('886) discloses an integrated light and accessory assembly 10 (Figure 1, column 7, line 17) being powered with the main electrical battery system of the vehicle. However, DeLine et al. ('886) does not teach an additional battery mounted on the housing , and connected to the conductor.

On the other hand, Hicks ('858) discloses a modular side view mirror assembly comprising a rechargeable battery 43 (Figure 1, column 2, lines 27 and 60-63) connected to a connector 421 leading to the light source 42 (Figure 1).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the first embodiment of the integrated light and accessory assembly of DeLine et al. ('886) by adding a additional battery as taught by for benefits and advantages of redundant power supply and reduce main battery drainage.

Allowable Subject Matter

8. Claims 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record, including DeLine et al. (U.S. Patent No. 6,124,886), fails to show or suggest the applicant's invention as claimed. Specifically, the prior art of record does not disclose proper motivation for combining an additional layer of insulation mounted on at least one conductor, and a ground plane mounted to the additional layer of insulation as recited in Claim 13.

Response to Amendment

9. Applicant's arguments filed on July 2, 2003 with respect to the 35 U.S.C. 102(e) rejections of claims) rejections of claims 1-5 and 14-19, 35 U.S.C. 103(a) rejections of claims 6-8, 11 and 12 have been fully considered but they are not persuasive.

Argument: A switch by it self is not a control module, and the entire assembly, as taught by DeLine et al. ('886) in column 7, lines 16 and 17, is not a control module. Therefore, DeLine et al. ('886) does not anticipate claims 1 and 2-5.

Response: The switches 72a and 72b (DeLine, Figures 1 and 4, column 9, lines 29-32), coupled to the plug connections 70a and 70b, control or supply power to the lamps 72a and 72 b. Therefore, the switches 72a and 72b electrically coupled to the power supply have been interpreted as control modules.

Argument: DeLine et al. ('886) in Figure 47 teaches an upper rearview mirror assembly in the first housing, and the second lower assembly in the second housing. Therefore, DeLine et al. ('886) does not teach "an integrated light and accessory assembly.

Response: Claim 14 recites a housing , enclosing the insulator, at least one reflector, at least one conductor, at least one lamp and an electronic module. DeLine et al. ('886) teaches a housing 502,507 (Figure 47, column 27, line 13) - the housing having a first compartment 502 and a second compartment 507- enclosing the reflector, conductor embedded in the insulator 510, lamp 508h and electronic module 508l.

Applicant's point is well taken, however, the fact that DeLine's housing is composed of two parts 502 and 506 (Figure

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47) does not negate the fact that the housing encloses the claimed elements.

Response: It requires improper hindsight for examiner to pick a feature at a time from the prior art, such as light sensor, without realizing the need for additional structural elements supporting the feature indicated above.

Applicant's arguments have been fully considered but they are not persuasive. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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Conclusion


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S Sawhney whose telephone number is 703-306-5909. The examiner can normally be reached on 6:15 - 2:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 703-305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306/7724 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2956.

HSS

10/21/2002


Stephen Husar
Primary Examiner